

Remarks

The specification has been amended to correct typographical and formality errors. In particular, the first paragraph of the specification has been amended to specify the relationship between the present application and prior applications from which the present application claims priority. The term "Table 1" has been added to the title of the table on page 9 of the specification. The terms "BufferH" and "EC" in Table 1 of the specification have been replaced with "Buffer^H" and "^oC," respectively. Applicants have also replaced the term "^a500" with "500" in paragraph 78 of the specification. In addition, Applicants have added SEQ ID NOs for all of the sequences in paragraphs 68, 69, 70, 71, 73, 87, and 91 of the specification. Applicants have also amended the sequence listing to incorporate the newly added SEQ ID NOs.

Claims 1-2, 4-12, and 16-18 remain pending in the application. Claims 13-15 have been withdrawn by the Examiner. Applicants have canceled claim 3 without prejudice or disclaimer. New claims 19-37 are added herein.

Applicants have amended claims 1-2, 4-12 and 16 with the initial phrase "isolated, recombinant or chemically synthesized." This amendment is supported at least by paragraphs 38-45 of the specification. In addition, Applicants have amended claims 2 and 10 to replace the term "and of" with "of." The amendment is supported at least by paragraph 7 of the specification and original claims 2 and 10. Furthermore, Applicants have amended claim 10 to recite "wherein said stringent condition is selected from the group consisting of conditions A to R of Table 1." The amendment is supported at least by paragraph 34 and Table 1 of the specification.

New claims 19-37 are added. The new claims are supported at least by Tables 1 and 2, Example 8, and paragraphs 38-45 and 55-58 of the specification.

Applicants respectfully submit that these amendments to the specification, sequence listing and claims do not introduce new matter. Accordingly, entry of the amendments is respectfully requested.

Restriction Requirement

On page 2, the Office Action deems the restriction requirement of withdrawing claims 13-15 proper. Applicants respectfully disagree. Applicants reserve the right to petition the Commissioner to review the restriction requirement pursuant to 37 CFR § 1.144.

Priority Claims

On pages 2-4, the Office Action requests Applicants to specify the relationship between the present application and prior applications from which the present application claims priority. Applicants have amended paragraph 1 of the specification to address the Examiner's concern and provide the requisite priority history.

In addition, Applicants submit herewith a petition to accept an unintentionally delayed priority claim under 37 CFR § 1.78(a)(3).

Sequence Listing

On pages 4-5, the Office Action requests Applicants to review the application in its entirety for compliance with the sequence listing rules. Applicants have amended the specification to include SEQ ID NOs for all of the sequences. Applicants respectfully submit that the amended specification complies with the sequence listing rules.

Moreover, Applicants have amended both the paper copy and the computer readable form of the Sequence Listing to incorporate the newly-added SEQ ID NOs. Applicants respectfully submit that the amendments to the specification and the Sequence Listing obviate the Examiner's concern.

Claim Rejections Under 35 U.S.C. § 101

On pages 5, the Office Action rejects claims 1-12 and 16 under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Applicants have canceled claim 3 without prejudice or disclaimer. This cancellation renders the rejection of claim 3 moot. In addition, Applicants have amended claims 1-2, 4-12 and 16 by adding the phrase "isolated, recombinant or chemically synthesized." Applicants submit that this amendment overcomes and obviates the Examiner's rejection of these claims. Withdrawal of the rejection is, therefore, respectfully requested.

Claims Rejections Under 35 U.S.C. § 112 (Enablement Rejection)

On pages 5-8, the Office Action rejects claims 2, 10, and 16-18 under 35 U.S.C. § 112, first paragraph, for nonenablement. Applicants respectfully traverse the rejection.

Applicants have amended claim 2 to replace the term "and of" with "of." Claim 2 does not encompass all β -amyloid peptide-binding proteins. Instead, claim 2 prescribes polynucleotides comprising a "nucleotide sequence of a β -amyloid peptide-binding protein

(BBP) of clone BBP1-fl deposited under accession number ATCC 98617, or a degenerate variant of said sequence.” Accordingly, Applicants respectfully submit that claim 2 meets the enablement requirement.

Applicants have also amended claim 10 to replace the term “and of” with “of.” In addition, Applicants have amended claim 10 to recite “said stringent condition is selected from the group consisting of conditions A to R of Table 1.” Applicants believe that this amendment, too, overcomes and obviates the Examiner’s rejection of claim 10.

Claims 16-18 depend from patentable claims 1 or 10. Accordingly, Applicant respectfully submit that claims 16-18 are also patentable.

Based on the foregoing, Applicants respectfully submit that claims 2, 10, and 16-18 satisfy the enablement requirement. Reconsideration and withdrawal of the § 112, first paragraph, nonenablement rejection is, therefore, respectfully requested.

Claim Rejections Under 35 U.S.C. § 112 (Written Description Rejection)

On pages 8-9, the Office Action rejects claims 2-3, 6-7, 10, and 16-18 under 35 U.S.C. § 112, first paragraph, for allegedly failing to satisfy the written description requirement. In particular, the Office Action contends that the specification does not provide a repeatable method for obtaining clone BBP-fl deposited under accession number ATCC 98617 or clone pEK 196 deposited under accession number ATCC 98399. Applicants respectfully traverse the rejection.

Without agreeing with the contention of the Office Action, Applicants submit herewith a declaration concerning deposits made under the Budapest treaty. Applicants believe that the declaration overcomes and obviates the Examiner’s rejection of claims 2, 6-7, 10, and 16-18. Withdrawal of the rejection is, therefore, respectfully requested.

Additionally, Applicants have canceled claim 3, thereby rendering the rejection of claim 3 moot. Reconsideration and withdrawal of the § 112, first paragraph, written description rejection is, therefore, respectfully requested.

Claims Rejections Under 35 U.S.C. § 112 (Indefiniteness Rejection)

On pages 9-10, the Office Action rejects claims 2, 10 and 16-18 under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicants respectfully traverse the rejection.

Applicants have amended claims 2 and 10 to replace the term “and of” with “of.” In addition, Applicants have amended claim 10 to recite “said stringent condition is selected from the group consisting of conditions A to R of Table 1.” Applicants respectfully submit

that the aforementioned amendment to claims 2 and 10 overcomes and obviates the Examiner's rejection. Reconsideration and withdrawal of the § 112, second paragraph, indefiniteness rejection of claims 2, 10 and 16-18 is, therefore, respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicants respectfully submit that the outstanding rejections have been overcome and the case is now in condition for allowance. Applicants, accordingly, respectfully request that a timely Notice of Allowance be issued in this case. Although Applicants believe that the amount of the enclosed fee is correct, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 19-2380.

Should the Examiner have any further suggestions or observations that would facilitate further prosecution or allowance of this case, the Examiner is invited to contact Applicants' representative designated below.

Date: July 15, 2004

Respectfully submitted,



Raymond Van Dyke
Reg. No. 34,746

Nixon Peabody LLP
Suite 900
401 9th Street
Washington D.C. 2004-2128
Tel: (202) 585-8250
Fax: (202) 585-8080